

copolymerized petroleum resin, alicyclic petroleum resin, hydrogenated petroleum resin and alkyl phenol resin (Claim 3).

The rejections of Claims 1-6 under 35 U.S.C. §102 and 35 U.S.C. §103 over: (a) JP 09316417, JP 40814384, or JP 408041434; (b) Hagiwara et al (US 4,373,046), Iwata et al (US 4, 400,486), Traynor et al (US 4,726,982), Lin et al (US 5,045,396), Miyajima et al (US 5,229,447), Gotoh et al (US 5,232,787), Sawamoto et al (US 5,318,835), or Yanagi et al (US 5,596,028); and (c) Murakami et al (US 5,998,018), Arakawa et al (US 6,120,866), or Hosokawa et al (US 6,312,799), are obviated by amendment by amendment and traversed in part.

The claims of the present invention are directed to a radiation-resistant *medical* adhesive product and a method for sterilizing the same. Applicants submit that none of the art of record disclose or suggest a radiation-resistant *medical* adhesive product. Moreover, the art of record is silent with respect to radiation-resistant properties of the adhesive product.

The standard for determining anticipation requires that the reference “must teach every element of the claim” (MPEP §2131). Therefore, the absence of any disclosure or suggestion in any of the art of record of a medical adhesive and radiation-resistant properties for the adhesive product would necessarily make these references fail to anticipate the present invention.

In making the rejections under 35 U.S.C. 102/103, the Examiner concludes that the tackifier resins disclosed in the art of record is “sufficient to meet the radiation-resistant agent” (see pages 3-8 of paper number 3) and that it “would be expected that the adhesive compositions and articles... would possess the claimed properties since the compositions... are *essentially* the same as and made in *essentially* the same manner as the claimed acrylic adhesive composition” (see pages 4, 7, and 8 of paper number 3). MPEP §2112 states:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

As stated above, the Examiner states that the compositions are *essentially* the same as and made in *essentially* the same manner as the claimed adhesive composition; however, the Examiner has not provided any basis in fact and/or technical reasoning to reasonably support the determination that the radiation-resistant properties necessarily flow from the compositions in the art of record. Moreover, MPEP §2112 further states: “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (see *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Accordingly, Applicants submit that the Examiner has not made out a proper case to support a *prima facie* case of obviousness, much less an anticipation rejection.

Citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), MPEP §2143.03 states: “To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” Applicants submit that the disclosures of the art of record fail to meet this requirement, and as such the artisan would have no reasonable motivation to compile the composition of the present invention or any reasonable expectation of the advantageous obtained thereby.

The rejection of Claims 1-6 under 35 U.S.C. §112, first paragraph, is obviated by amendment. Withdrawal of this ground of rejection is respectfully requested.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Vincent K. Shier, Ph.D.
Registration No. 50,552



22850

(703) 413-3000
Fax #: (703) 413-2220
NFO/VKS:sjh

MARKED-UP COPY

IN THE CLAIMS

Claims 1-2. (Canceled).

3. (Amended) A radiation-resistant medical adhesive product comprising [the radiation-resistant acrylic adhesive composition described in claim 1] an acrylic polymer and a radiation-resistant agent selected from the group consisting of rosin, rosin derivatives, terpene resin, terpene phenol resin, aromatic modified terpene resin, hydrogenated terpene resin, aliphatic petroleum resin, aromatic petroleum resin, copolymerized petroleum resin, alicyclic petroleum resin, hydrogenated petroleum resin and alkyl phenol resin.

4. (Amended) [A] The radiation-resistant medical adhesive product [comprising the radiation-resistant acrylic adhesive composition described in claim 2] according to claim 3, wherein the amount solid content of the radiation-resistant agent is 5 to 100 parts by weight relative to 100 parts by weight solid content of the acrylic polymer.

5. (Amended) The radiation-resistant medical adhesive product [comprising a radiation-resistant acrylic adhesive composition] according to claim 3, wherein the adhesion thereof after irradiation with 60 kGy electron rays, as determined in accordance with JIS Z0237, is 80 to 100% of the adhesion thereof before irradiation.

6. (Amended) The radiation-resistant medical adhesive product [comprising a radiation-resistant acrylic adhesive composition] according to claim 4, wherein the adhesion thereof after irradiation with 60 kGy electron rays, as determined in accordance with JIS Z0237, is 80 to 100% of the adhesion thereof before irradiation.

Claims 7-23. (New).